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Docket EPC-71

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : **Bertram V. Burke**
Serial No. : **09/314,424**
Filed : **May 18, 1999**
For : **Voucherless Rebate System**
Art Unit : **3622**
Examiner : **Jean D. Janvier, Tel 703-308-6287, Fax 703-746-7238**

Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

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AMENDMENT

GROUP 3600

Sir:

Submitted herewith is a complete set of claims showing amendments to the claims. A copy of the claims showing amendments is included to indicated passages and figures supporting the amendments. Also attached are amendments to the specifications. Claims 1 to 30 are now in the application.

Reconsideration is respectfully requested of the comment concerning the abstract. Applicant has adopted the Examiner's suggestion by placing the absent comma where indicated.

Reconsideration is respectfully requested of the objection to claims "4 and 10 and 6". Applicant has amended the claims to read that the "merchant agrees to **pay** the rebates" as set forth in the specification, for example, at page 4 line 3 and page 15 line 20.

Reconsideration is respectfully requested of the rejection of claims 2 to 6 and 7 under 35 USC 101 as being directed to non-statutory subject matter. Applicant has adopted the Examiner's suggestion for amending these claims. The claim now reads "A computer program product encoded on a computer readable medium residing in a computer of a central clearinghouse, comprising a code that when executed on the computer perform the steps of:" Thus it is respectfully requested that this rejection be withdrawn.

Reconsideration is respectfully requested of the rejection of claims 1 to 27 under 35 USC 103 as unpatentable over Burke patent 5,621,640 (Burke 5,621,640) in view of Hovakimian patent 5,466,919 (Hovakimian) on two grounds. As to the first ground, applicant is claiming the benefit of Burke 5,621,640, through a series of applications. In accordance with the Examiner's comments, the claim for benefit now appears in the specification. The Examiner is respectfully thanked for pointing out that the list of applications, previously submitted only in the remarks, inadvertently included two applications, which were filed after the present application. These have been removed. It should be noted that the present application receives the benefit of the earliest application Serial Number 08/018,821 filed February 18, 1993 twice, along two parallel branches, one through Serial No. 08/429,758, and the other through Serial Number 08/843,424. Thus Burke 5,621,640 is not a proper reference in this application. The Hovakimian patent 5,466,919 has it earliest filing date, April 2, 1993, after the February 18, 1993 earliest effective filing date of the present application. Thus Hovakimian patent 5,466,919 is also not a proper reference in this application.

Reconsideration is respectfully requested of the rejection of claims 1 to 27 under 35 USC 103 as unpatentable over Burke patent 5,621,640 in view of Hovakimian patent 5,466,919 on a second alternative ground. Claims 1 and 28 to 30 are believed to be distinct and non-obvious from the from these references alone or in combination by virtue of: "in computer code, calculating in the central clearinghouse rebates determined by said merchant on the basis of purchases of the supporter from said merchant and to be paid by the merchant to the nonprofit; and in computer code, deducting from the purchases of the supporter from said merchant the calculated rebates determined by the merchant and in computer code forwarding to said nonprofit the calculated and deducted rebates to be paid by the merchant to said nonprofit."

Claims 2 to 7 are believed to be distinct and non-obvious from the from these references alone or in combination by virtue of: "in the computer system, on computer readable media including codes that when executed perform steps, deducting and recording rebates, determined by the merchants and to be paid by the merchants to the organizations, from purchases of the supporter from said merchants in each of the transactions; and in computer code, transmitting to the organizations the rebates, deducted from purchases of the supporter from said merchants in said transactions between said supporter and the merchants, and to be given to the organizations."

Claims 7 is believed to be distinct and non-obvious from the from these references alone or in combination by virtue of: "maintaining, in a code to be executed on the

computer, a schedule of rebates determined by each of the one or more the merchants due to each of the one or more organizations from each of the merchants; ...calculating, in a code to be executed on the computer, the rebates due from the merchant to the organization; and transmitting, in a code to be executed on the computer, to the one or more organizations, the amount of rebates determined by the one or more merchants and due the one or more organizations from each of the merchants.”

Claims 8 to 27 are believed to be distinct and non-obvious from the from these references alone or in combination by virtue of: “in computer code, entering into said clearinghouse computer network a rebate calculation determined by said merchants on the basis of transactions with said supporters, for payment of rebates by the merchants to said nonprofit organizations; and in computer code, having payments credited, on the basis of said transactions and said rebate calculations determined by said merchants, from said merchants to said nonprofit organizations.”

The dependent claims are further believed to be distinct and non-obvious from any combination of the aforementioned references by virtue of the features particularly recited therein.

None of the references, alone or in combination, suggests these features or in any sense make the claims obvious. In Burke, it is the **customer that chooses an amount and adds the amount**, chosen by the customer, to the total charged by the merchant,

and the clearinghouse sends the **added amount** to a charity or other destination. In the claimed invention, the **merchant determines the amount to rebate from the total** charged by the merchant, and that amount is rebated to the destination organization.

This is set forth precisely on page 5 third paragraph of the specification as follows:

“In Fig. 1, the merchant component(s) (MC) uses an ETx to communicate with the CC. **The ETx allows the MC to:** (a.) enroll in the program, (b.) obtain a merchant account number (ID), (c.) obtain a personal identification number (PIN) needed to access its account, (d.) choose one or more NC's to receive rebates, (e.) enroll SC's (at the store level) and assign SC's ID's, (f.) select SC's who will qualify for rebates, (g.) **determine the amount of rebate available, (h.) specify the required activity needed to qualify for a rebate,** and (g.) request activity reports, rebate reports, and other information stored in the CC. ”

Hovakimian adds nothing to the aforementioned, alone or combined, to make the claims obvious. In Hovakimian, the purchaser makes the donation, not the merchant.

The **Examiner admits** that Burke does not disclose or suggest a method and/or system for deducting calculated rebates, as determined by a merchant or retailer, based on purchases made by a supporter or customer or donor at the merchant's or retailer's to thereby forward, for payment by the merchant or retailer, the calculated and deducted

rebates to a non-profit organization or charity. The Examiner mentions Hovakimian. However, the **Examiner never even alleges or concludes** that Hovakimian suggests that the **merchant determines the amount to rebate from the total**. Rather the **Examiner admits** that in Hovakimian:

“the issuer of the credit card agrees to deduct a certain portion (calculated rebates) from each identified purchaser's transaction involving the credit card **and subsequently donate** the accumulated portions or rebates to the charity or charities pre-selected by the identified purchaser or customer in an effort to encourage the identified purchaser to use the credit card to pay for transactions.”

The Examiner seems to confuse the issue by alleging that the merchant and the credit card issuer are one and the same. This appears in the official action as follows:

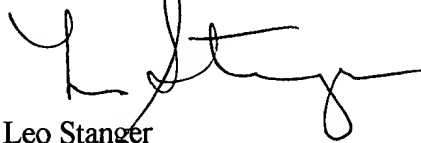
“It is the cumulative credit or rebate given to the purchaser by a third party or merchant, wherein the third party is a credit card merchant or a credit card issuer, whenever the purchaser uses the issuer’s credit card to pay for transactions at participating merchants or retailers; in other words, it is the merchant's or credit card issuer's money, not the purchaser's change due or money, that is donated to the non-profit organizations.” (Emphasis added.)

This is totally false. At no point does Hovakimian suggest that the merchant donates the money. Hovakimian only suggest the credit card issuer. That is not the same as the merchant. The Examiner is lumping the two together. Simply using the term “or” as the Examiner does, fails to

make them identical. They are not the same.

In view of the above it is respectfully requested that the claims be allowed and
the case passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Leo Stanger', with a long horizontal flourish extending to the right.

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